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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,607	12/11/2003	Robert W. Erickson	RCM 03324	8510

7590 02/06/2007  
JAMES RAY & ASSOCIATES  
2640 PITCAIRN ROAD  
MONROEVILLE, PA 15146

EXAMINER
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SINGH, SUNIL

ART UNIT	PAPER NUMBER
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3673

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/733,607

Applicant(s)

ERICKSON, ROBERT W.

Examiner

Sunil Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-12, 16, 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 calls at least one groove having a first predetermined length formed in an outer surface of a shank portion of said cutting tool and at least two grooves each having a second predetermined length which is longer than said first predetermined length; however, such subject matter was never disclosed in the originally filed disclosure.

**Insofar applicant's drawings show at least one groove having a first predetermined length formed in an outer surface of a shank portion of said cutting tool and at least two grooves each having a second predetermined length which is longer than said first predetermined length then so do the prior art below.**

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6-12, 16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krekeler '637 in view of Krekeler '206.

Krekeler '637 discloses a retaining system (see Fig. 4) for securing a cutting tool to a support block, said retaining system comprising: at least one groove (22) having a first predetermined shape, formed in an outer surface of a shank portion of said cutting tool intermediate each end thereof, said groove being formed in a direction transverse to a longitudinal axis of said shank; at least one groove (23) having a second predetermined shape, formed in a surface of a bore formed through an axis of said support block for receiving therein said shank portion of said cutting tool, said at least one groove formed in said outer surface of said shank portion of said cutting tool being substantially radially opposed to said at least one groove formed in said surface of said bore formed through said axis of said support block when said shank portion is inserted into said bore of said support block; and at least one rolled spring steel pin member (24) (see col. 4 lines 15-25) engageable with each of said at least one groove formed in said outer surface of said shank portion said cutting tool and said at least one groove formed in said surface of said bore formed through said axis. Krekeler '637 discloses the invention substantially as claimed. However, Krekeler '637 is silent about including at least two

grooves and pins. Krekeler '206 teaches at least two grooves and pins (see Fig. 1). It would have been considered obvious to one of ordinary skill in the art to modify Krekeler '637 to include at least two grooves and pins as taught by Krekeler '206 in order to more securely retain the tool within the holder.

With regards to the limitation at least one groove having a first predetermined length formed in an outer surface of a shank portion of said cutting tool and at least two grooves each having a second predetermined length which is longer than said first predetermined length, insofar applicant's drawings illustrate such teaching then so does the above mentioned prior art.

5. Claims 1,6-12, 16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrow (US 3498677).

Morrow discloses the claimed invention except for at least two pins in the grooves. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Morrow to include at least two pins, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

With regards to the limitation at least one groove having a first predetermined length formed in an outer surface of a shank portion of said cutting tool and at least two grooves each having a second predetermined length which is longer than said first predetermined length, insofar applicant's drawings illustrate such teaching then so does the above mentioned prior art.

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6. Claims 1,6-12, 16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. or Krekeler '764 or Kniff et al., Krekeler '359 or Vasek or Stewart (US 3268260, 3498677, 3622206, 3690728, 3796464, 3834764, 3841708, 3856359, 4222446, 5810102) in view of Krekeler '206.

Hansen et al., Krekeler '764, Kniff et al., Krekeler '359, Vasek and Stewart all disclose a retaining system for securing a cutting tool to a support block. Hansen et al., Krekeler '764, Kniff et al., Krekeler '359, Vasek and Stewart all disclose the invention substantially as claimed. However, they are all silent about including at least two grooves and pins. Krekeler '206 teaches at least two grooves and pins (see Fig. 19, col. 10). It would have been considered obvious to one of ordinary skill in the art to modify either Hansen et al. or Krekeler '764 or Kniff et al., Krekeler '359 or Vasek or Stewart to include at least two grooves and pins as taught by Krekeler '206 in order to more securely retain the tool within the holder.

With regards to the limitation at least one groove having a first predetermined length formed in an outer surface of a shank portion of said cutting tool and at least two grooves each having a second predetermined length which is longer than said first predetermined length, insofar applicant's drawings illustrate such teaching then so does the above mentioned prior art.

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7. Claims 1,6-12, 16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. or Krekeler '764 or Kniff et al., Krekeler '359 or Vasek or Stewart (US 3268260, 3498677, 3622206, 3690728, 3796464, 3834764, 3841708, 3856359, 4222446, 5810102).

Hansen et al., Krekeler '764, Kniff et al., Krekeler '359, Vasek and Stewart all disclose the claimed invention except for at least two grooves and pins. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify either Hansen et al. or Krekeler '764 or Kniff et al., Krekeler '359 or Vasek or Stewart to include at least two grooves and pins, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With regards to the limitation at least one groove having a first predetermined length formed in an outer surface of a shank portion of said cutting tool and at least two grooves each having a second predetermined length which is longer than said first predetermined length, insofar applicant's drawings illustrate such teaching then so does the above mentioned prior art.

8. Claims 1, 3-12, 16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bower, Jr. (US 3493268) in view of Krekeler '206. Bower, Jr. discloses the invention substantially as claimed (see Figures). However, Bower, Jr. is silent about including at least two grooves and pins. Krekeler '206 teaches at least two grooves and pins (see Fig. 19, col. 10). It would have been considered

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obvious to one of ordinary skill in the art to modify Bower, Jr. to include at least two grooves and pins as taught by Krekeler '206 in order to more securely retain the tool within the holder.

With regards to the limitation at least one groove having a first predetermined length formed in an outer surface of a shank portion of said cutting tool and at least two grooves each having a second predetermined length which is longer than said first predetermined length, insofar applicant's drawings illustrate such teaching then so does the above mentioned prior art.

9. Claims 1, 3-12, 16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bower, Jr. (US 3493268).

Bower Jr. discloses the claimed invention except for at least two grooves and pins.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bower Jr. to include at least two grooves and pins, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With regards to the limitation at least one groove having a first predetermined length formed in an outer surface of a shank portion of said cutting tool and at least two grooves each having a second predetermined length which is longer than said first predetermined length, insofar applicant's drawings illustrate such teaching then so does the above mentioned prior art.



10. Claims 1, 2-12, 16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wipo document (WO 00/34626) in view of Krekeler '206 (US 3622206).

Wipo '626 discloses the invention substantially as claimed (see Figure 16). However, Wipo '626 is silent about including a groove in the shank of the cutting tool and at least two pins for the grooves (46). Krekeler '206 teach a groove in the shank of a cutting tool (see col. 20 line 5+) and at least two pins for two grooves (see Fig. 19, col. 10). It would have been considered obvious to one of ordinary skill in the art to modify Wipo '626 by including a groove in the tool's shank and at least two pins for the two grooves as taught by Krekeler '206 since this would facilitate insertion because the pin will contract to permit insertion and due to its resiliency property rebound to retain the cutting tool in its holder and more securely retain the tool within the holder.

With regards to the limitation at least one groove having a first predetermined length formed in an outer surface of a shank portion of said cutting tool and at least two grooves each having a second predetermined length which is longer than said first predetermined length, insofar applicant's drawings illustrate such teaching then so does the above mentioned prior art.

### ***Response to Arguments***

11. Applicant's arguments filed 10/12/06 have been fully considered but they are not persuasive. Applicant argues that at least one groove having a first predetermined length formed in an outer surface of a shank portion of said cutting tool and at least two grooves each having a second predetermined length which is longer than said first

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predetermined length in not new matter since it is illustrated in Fig. 1. The examiner does not concur. Since applicant does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue."). However, the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. In *re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977) ("We disagree with the Solicitor's conclusion, reached by a comparison of the relative dimensions of appellant's and Bauer's drawing figures, that Bauer clearly points to the use of a chime length of roughly 1/2 to 1 inch for a whiskey barrel.' This ignores the fact that Bauer does not disclose that his drawings are to scale. ... However, we agree with the Solicitor that Bauer's teaching that whiskey losses are influenced by the distance the liquor needs to traverse the pores of the wood' (albeit in reference to the thickness of the barrelhead)" would have suggested the desirability of an increased chime length to one of ordinary skill in the art bent on further reducing whiskey losses." 569 F.2d at 1127, 193 USPQ at 335-36.)

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

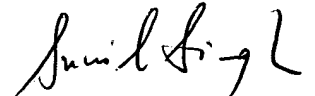
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Engle Patricia can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sunil Singh  
Primary Examiner  
Art Unit 3673



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